

Attorney Docket No. JP920000095US1

REMARKS

The present application was filed on May 15, 2001 with claims 1-22. Claims 1, 7, 9, 12, 16, 18 and 20-22 are the independent claims. In the outstanding Office Action, the Examiner: (i) rejected claims 1-4, 9-11, 16, 17 and 20-22 under 35 U.S.C. §101 as being directed to non-statutory subject matter; (ii) rejected claims 1-9, 11, 18, 19, 21 and 22 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,102,406 to Miles et al. (hereinafter "Miles"); and (iii) rejected claims 10, 12-17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Miles in view of U.S. Patent No. 6,523,027 to Underwood (hereinafter "Underwood").

In response to the rejections presented above, claims 1-22 have been amended. However, Applicants assert that such amendments should be entered since they raise no new issues that would require further consideration and/or search. No new matter has been added.

Regarding the rejection of claims 1-4, 9-11, 16, 17 and 20-22 under 35 U.S.C. §101, Applicants have amended independent claims 1, 9, 16 and 20-22 to more clearly recite statutory subject matter. More specifically, independent claims 1, 16, 21 and 22 have been amended to recite that the limitations are performed on a computer. Additionally, independent claim 9 has been amended to recite a server, and independent claim 20 has been amended to provide functionality for the object. Accordingly, withdrawal of the rejection of claims 1-4, 9-11, 16, 17 and 20-22 under 35 U.S.C. §101 is therefore respectfully requested.

Regarding the rejection of claims 1-9, 11, 18, 19, 21 and 22 under 35 U.S.C. §102(e) as being anticipated by Miles, Applicants assert that Miles fails to teach or suggest all of the limitations in independent claims 1, 7, 9, 18, 21 and 22 for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on Miles does not meet this basic legal requirement. Support for this assertion follows.

The present invention, for example, as recited in independent claim 1 recites a user guidance method performed on a computer. An object is incorporated into a specific web site at a specific

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location. The object is capable of being selected by a user in order to provide a reward for the user. The object is moved from the specific location to a different location, and at least one user desiring to select the object is guided to predetermined content available at the specific web site. Independent claim 7 recites similar limitations.

Miles discloses an Internet-based advertising scheme employing a scavenger hunt metaphor. During the scavenger hunt the user may click on a hyperlink of a web page to return to the scavenger hunt game site in order to answer a specific question regarding the content of the web page. If the user meets specific requirements and answers the question correctly, the user may select a new clue directed to another web page having a hyperlink.

Miles fails to disclose the moving of the object as recited in independent claims 1 and 7. In providing support for the rejection the Examiner directs Applicants to a portion of Miles describing the repeating of the process of finding information on a web page and returning to the game site through a hyperlink. However, Miles contains no description or suggestion that the hyperlink moves. To the contrary, Miles describes embodiments in which many users play the scavenger hunt game at the same time, during which the hyperlinks must remain on the individual web pages so that each player is able to play. Therefore, contrary to the Examiner contention, Miles requires multiple fixed hyperlinks, without the movement recited in claims 1 and 7 of the present invention.

Further, the Examiner contends that having a link appear at a different page, after a previous page is accessed, is inherently moving. Miles does not contain the disclosure which is necessary to support a claim rejection on the basis of inherency. According to the Court of Customs and Patent Appeals (CCPA), "Inherency does not mean that a thing might be done, or that it might happen, ...; but it must be disclosed, if inherency is claimed, that the thing will necessarily happen." *In re Draeger et al.*, 150 F.2d 572, 574 (CCPA 1945) (emphasis supplied). Furthermore, the well settled law "requires that inherency may not be established by possibilities and probabilities. The evidence must show that the inherency is necessary and inevitable." *Interchemical Corp. v. Watson*, 145 F.Supp. 179, 182, 111 USPQ 78, 79 (D. D.C. 1956) (emphasis supplied), *aff'd*, 251 F.2d 390, 116 USPQ 119 (D.C. Cir. 1958).

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Additionally, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). There is no reasonable basis for an assertion that moving an object from a specific location of a specific site to a different location, necessarily flows from the existence of the same hyperlink on separate web pages as disclosed in the Miles reference, and thus is inherent. No such basis and/or technical reasoning has been provided by the Examiner in the final Office Action.

In response to these arguments which were previously presented by Applicants, the Examiner contends that in Miles "as the user makes his way through the various clues and corresponding target web pages, he perceives the hyperlink object as moving to a different target page for the answer to each clue." However, as described above, while the user may be moving to a new web page having a hyperlink, the hyperlinks themselves are not actually moving to a new page, but remain fixed on each page. Finally, it is not what a user may perceive, but what is actually occurring with regard to the hyperlinks in Miles which should be compared to the claims of the present invention.

Independent claim 9 recites a computer-based user guidance system having a server comprising an object manager for managing the location and movement of an object on a network. The server also comprises a position information generator for generating information concerning the location of the object, and for providing the information to a user who is accessing the network. Finally, the server comprises a processor for performing a predetermined process associated with the object selection, when the object is selected by a predetermined user. The object manager arranges the object at a desired location in order to guide the user to desired contents on the network. Miles fails to disclose an object manager that manages the location and movement of an object on a network and arranges the object at a desired location to guide the user to the desired content on the network, as described above with regard to claim 1.

Independent claim 18 recites a computer-based object control system comprising an object stored in a predetermined server. The object control system also comprises a link setting means for setting a link in a web page stored at a web site on the network in order to move to the object.

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Finally, the object control system comprises an object position management means for determining a web page for setting a link thereto. Under the control of the object position management means the link setting means changes a target web page for setting a link thereto. Miles fails to disclose a link setting means for setting a link in a web page to move the object. The portion of Miles referred to by the Examiner describes the clicking of a hyperlink to return to a scavenger hunt game site, but does not describe movement of the hyperlink, as described above with regard to claim 1.

Independent claim 21 recites a storage medium on which input means of a computer stores a program in an input-enabled form. The program causes the computer to perform a process for incorporating a specific object into a specific web page stored in a specific web server. The program also causes the computer to perform a process for moving the object to another web page when a user browses the specific web page and selects the specific object. Independent claim 22 recites similar limitations to those of claim 21. Miles fails to disclose a process for moving the object to another web page when a user browses the specific web page, as described above with regard to claim 1.

Dependent claims 2-6, 8, 11 and 19 are patentable at least by virtue of their dependency from independent claims 1, 7, 9 and 18. Dependent claims 2-6, 8, 11 and 19 also recite patentable subject matter in their own right. For example, with regard to claim 2, Miles fails to disclose the incorporation of the object into the specific web site at a different location after the object has been selected by the user. Accordingly, withdrawal of the rejection of claims 1-9, 11, 18, 19, 21 and 22 under 35 U.S.C. §102(e) is therefore respectfully requested.

Regarding the rejection of claims 10, 12-17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Miles in view of Underwood, Applicants assert that the Examiner has failed to set forth a proper *prima facie* case of obviousness as set forth in M.P.E.P. §2143.

Three requirements must be met to establish a *prima facie* case of obviousness. First, the cited combination must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation to combine reference teachings. While it is sufficient to show that a *prima facie* case of obviousness has not

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been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that even if combined, the Miles and Underwood references, when considered either individually or in combination, fail to teach or suggest all of the limitations of independent claims 12, 16 and 20. For at least this reason, a *prima facie* case of obviousness has not been established.

Independent claim 12 recites a computer-based object control system comprising web servers for storing web pages. The object control system also comprises a main server for communicating with a predetermined web server. The main server incorporates a specific object into a first specific web page and removes the specific object from a second specific web page stored in the specific web server. Underwood discloses a system for providing an interface between a first server and a second server with a proxy component situated therebetween. While Underwood discloses the creation, retrieval, updating and deletion of business objects, it fails to disclose the movement of an object between web pages. Thus, Underwood fails to make up for the deficiencies described above with regard to Miles, and the combination of Miles and Underwood fails to disclose a main server that incorporates the object into a first web page and removes the object from a second web page.

Independent claim 16 recites an object control system of a computer comprising an object to be embedded in a web page stored at a web site on a network. The object control system also comprises an object management means for managing the location of the object on the network. The object management means changes the location of the object on the network in order to move the object across the network. Again, the combination of Miles and Underwood fails to disclose the changing of the location of the object on the network in order to move the object across the network, as described above with regard to claim 12.

Independent claim 20 recites a moving object to be embedded in a web page stored at a web site on a network, which moves from a predetermined web page to another web page and is capable of being selected by a user in order to provide a reward for the user. The location on the network is managed by specific management means. The combination of Miles and Underwood fails to disclose

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an object, capable of being selected by the user in order to provide a reward for the user, which moves from a predetermined web page to another web page, as described above with regard to claim 12.

Second, with respect to claims 12, 16 and 20, even assuming, *arguendo*, that the Miles and Underwood references can be combined, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Miles and Underwood absent the teachings of the present invention. For at least this reason, a *prima facie* case of obviousness has not been established. Despite the assertion in the Office Action, Applicants do not believe that Miles and Underwood are combinable since it is not clear to one skilled in the art how one would combine them. There is no guidance provided in the Office Action to support such a combination.

Third, there is clear lack of motivation to combine the references. Applicants assert that no motivation or suggestion exists to combine Miles and Underwood in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a *prima facie* case of obviousness has not been established. Applicants strongly believe that one ordinarily skilled in the art would not look to Underwood's servers interface to modify Miles' Internet scavenger hunt advertising model. That is, the teachings in the references are directed to completely different areas; a first (Miles) toward a method for advertising on the Internet, and a second (Underwood) toward software framework designs. However, other than very general and conclusory statements in the final Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277, F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." *Id.* at 1343-1344.

In the Office Action at pages 9-12, the Examiner provides the following statements to prove motivation to combine Miles and Underwood, with emphasis supplied:

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It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the database with the main server.
(Pages 9 and 10)

It would have been obvious to combine the teachings of Miles and Underwood to facilitate the integration of the third party advertiser sites with the main server.
(Page 10)

It would have been obvious to combine the teachings of Miles and Underwood to include the use of objects created outside of a web page file, such as embedded pictures.
(Pages 11 and 12)

Applicants submit that these statements are based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

In response to these arguments which were previously presented by Applicants, the Examiner contends that “Underwood discusses an e-commerce architecture that provides a connected interface between a first and second server, . . . Miles states that usually advertisers sites are hosted on resources other than the main server . . . and therefore a connection between the two must occur in order to allow users to follow the given clues.” However, the Examiner fails to provide any objective evidence that supports the combination of the creation, retrieval, updating and deletion of business objects in an e-commerce architecture, with hyperlinks in a scavenger hunt game. Additionally, the Examiner has only addressed one of the conclusory statements provided in the final Office Action and quoted above.

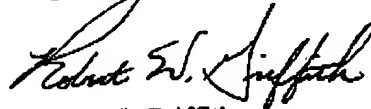
Dependent claims 10, 13-15 and 17 are patentable at least by virtue of their dependency from independent claims 9, 12 and 16. Dependent claims 10, 13-15 and 17 also recite patentable subject matter in their own right. For example, the combination of Miles and Underwood fails to disclose that the information concerning the location of the object, which is provided for the user, indicates the ease with which the object can be reached from the web page browsed by the user, as recited in

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dependent claim 15. Accordingly, withdrawal of the rejection of claims 10, 12-17 and 20 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-22 are in condition for allowance, and respectfully request withdrawal of the §101, §102(e) and §103(a) rejections.

Respectfully submitted,



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Robert W. Griffith
Attorney for Applicant(s)
Reg. No. 48,956
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-4547